

REMARKS

The Official Action of September 2, 2004 has been carefully considered and reconsideration of the application as amended is respectfully requested.

The basis for the rejection under 35 USC 112, second paragraph, has been removed by the deletion from claims 18 and 25-29 of the recitation in the carbocyclic ring that suggested the possibility of the carbocyclic ring comprising a C-N bond.

The only other rejection in the Official Action is the rejection of claims 26-27 under the written description requirement of 35 USC 112, first paragraph, arising from the recitation that R⁴ is CF₃. As noted by the Examiner, the rejection has previously been set forth in considerable detail, but it is respectfully submitted that there is a facet of this issue that the Examiner has not yet considered, as next discussed.

The Examiner has rejected Applicants' argument that the specific embodiments of R⁴ described in the specification at, for example, page 9, lines 10-11, fall within the genus of R⁴ described at, for example, page 4, lines 10-18, with the contention that there is no requirement in the specification as filed that the genus of R⁴ must embrace all of the disclosed species of R⁴, including CF₃. However, Applicants respectfully call the Examiner's attention to original claim 3 of the application, which depended from original claim 1. Since a proper dependent claim must include every limitation of the claim on which it depends (see MPEP Section 608.01(n)), it may be considered that the genera recited in original claim 1 were in fact intended to embrace the species in original

claim 3. In that case, it would be considered that the genus of R⁴ in original claim 1 was intended to embrace the species of R⁴ in original claim 3, including CF₃.

It is settled that an amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of error in the specification, but also the appropriate correction (see MPEP Section 2163.07). It is respectfully submitted that, since original claim 3 sought further to limit the compound defined in original claim 1 (“A compound according to claim 1 wherein. . .”), one of skill in the art would have recognized the existence of an error in the discrepancy between the R⁴ groups of the respective claims 1 and 3. It is also respectfully submitted that, in the face of this discrepancy, one of skill in the art would have realized that the appropriate correction would be the addition of CF₃ to the definition of the R⁴. This being the case, it is further respectfully submitted that the correction of this obvious error does not constitute new matter. Put another way, it is believed that one of skill in the art can reasonably conclude from the specification as filed, including the original claims, that the inventor had possession of the invention now claimed as of the application filing date.

In view of the above, it is respectfully submitted that all rejections and objections of record have now been overcome and that the application is now in allowable form. An early notice of allowance is earnestly solicited and is believed to be fully warranted.

Respectfully submitted,

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